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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,610	03/20/2006	Bernd Schepperle	ZAHFRI P831US	7124

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DAVIS BUJOLD & Daniels, P.L.L.C.
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CONCORD, NH 03301

EXAMINER

LE, DAVID D

ART UNIT	PAPER NUMBER
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3681

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/572,610	Applicant(s) SCHEPPERLE, BERND	
	Examiner David D. Le	Art Unit 3681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/20/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the first Office action on the merits of Application No. 10/572,610, filed on 20 March 2006. Claims 15-28 are pending.

Documents

2. The following documents have been received and filed as part of the patent application:
 - Copy of Foreign Priority Document, received on 03/20/06
 - Information Disclosure Statement, received on 03/20/06
 - Substitute Specification, received on 03/20/06

Information Disclosure Statement

3. The information disclosure statement filed on 20 March 2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document. The following foreign patent documents have been placed in the application file, but the information referred to therein have not been considered.
 - EP-0 633 412 A1;
 - DE-195 30 616 A1; and
 - DE-101 10 981 A1.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for embodiment as shown in Figs. 1-2, does not reasonably provide enablement for the claimed invention as recited in present claim 28. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with the claim.

Claim 28 recites the claimed limitation “wherein one of electro-mechanical actuators, pneumatic actuators, and hydraulic actuators are provided.” This claimed limitation requires a total of three actuators, which the present specification does not adequately support.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 15-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15:

- Lines 9-13 recite the limitation “wherein elements for carrying out the shift are manufactured from a material with relatively high structural strength while

elements of the selection apparatus and the blocking apparatus are manufactured of a material having less structural strength than the elements for carrying out the shaft.” It appears that the claimed recitation “elements for carrying out the shift” is in conflict with the claimed recitation “elements of the selection apparatus” since lines 3-6 of the present claim 15 describes the claimed shifting device using the shifting shaft with a plurality of shifting forks and the selection apparatus to carry out the shift.

Claim 16:

- Lines 6-7 recite, in part, the limitation “elements of a come-along apparatus (20, 22)”. This claimed limitation appears to be in conflict with lines 9-13 of the present independent claim 15 where the present claim 15 appears to define the elements of a come-along apparatus (20, 22) are part of the elements for carrying out the shift, not the elements of the selection apparatus.

Claim 17:

- Lines 2-3 recite, in part, the limitation "the blocking apparatuses". There is insufficient antecedent basis for this limitation in the claim.

Claim 21:

- Line 2 recites, in part, the limitation "the ring-shaped engagement unit". There is insufficient antecedent basis for this limitation in the claim.

Claim 27:

- Lines 1-2 recite, in part, the limitation “a transmission”. It is unclear whether this newly recited limitation “a transmission” is different from the one, which is first recited on line 1 of independent claim 15.

Claim 28:

- Claim 28 recites the limitation “wherein one of electro-mechanical actuators, pneumatic actuators, and hydraulic actuators are provided.” It is unclear whether the present claim 28 intends to claim a third actuator.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 15-28, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent No. 6,370,976 to Doppling et al. (hereinafter referred to as Doppling).

Claims 15-28:

Doppling (Figs. 1-7; column 1, line 59 - column 6, line 15) discloses a shift device comprising:

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- A shift shaft (i.e., Fig. 1, element 15);
- A plurality of shifting forks (i.e., Fig. 1, elements 12a, 12b, 12c);
- A selection apparatus (i.e., Fig. 2, element 2);
- A blocking apparatus (i.e., Fig. 1, element 20);
- Wherein the shift shaft (15) and the plurality of shifting forks (12a, 12b, 12c) are made from steel (i.e., column 3, lines 36-47 or column 5, lines 35-42);
- Wherein the selection apparatus (2) is made from plastic material (i.e., column 3, lines 36-47 or column 5, lines 35-42);
- A plurality of projections (i.e., Fig. 1, elements 13);
- A rotatable blocking disks (i.e., Fig. 1, elements 3 and 4); and
- An actuator (i.e., Fig. 1, element 16).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Beer et al. (U. S. Patent No. 7,225,700) teaches a gear shifting system, as shown in Fig. 1.
- Patzner et al. (U. S. Patent No. 6,691,590) teaches a shifting device, as shown in Fig. 1.
- Bieber (U. S. Patent No. 6,357,316) teaches a shifting device, as shown in Figs. 1-2.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Le whose telephone number is 571-272-7092. The examiner can normally be reached on Mon-Fri (0700-1530).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David D. Le/
Primary Examiner, Art Unit 3681
02/25/2008

ddl